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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/647,291

08/26/2003

Hiroyuki Moro

241856US2

2663

22850

7590

04/26/2006

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

LANE, JOHN A

ART UNIT

PAPER NUMBER

2185

DATE MAILED: 04/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/647,291

Applicant(s)

MORO, HIROYUKI

Examiner

Jack A. Lane

Art Unit

2185

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-22 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/3/05(2pages)</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office action is responsive to the Request for Continued Examination (RCE) under 37 CFR 1.114 filed 02/20/2006. Claims 1-22 are presented for examination.

2. Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

In the present disclosure, the Background section identifies several prior art devices and/or systems. In response to this Office action, the examiner requests identification of all independent claim limitations (claims 1, 2, 7, 14, 15, 21 and 22) corresponding to prior art elements in the background documentation. Since applicant is most knowledgeable of the present invention and the background art, a discussion of the background art with respect to the instant claims is essential. That is, for each claim limitation (including structural and functional limitations linking claim elements, e.g. coupled to, responsive to) identify a corresponding prior art element by page, line, and/or fig. The examiner is specifically looking for prior art elements corresponding to any of the following independent claim limitations. The following list appears to represent the main invention(s)/embodiment(s)

Capacity switch notification module which notifies...handles a capacity switching-type memory card.

Capacity switch authentication module which refers to...register...and authenticates whether...capacity switching-type memory card.

Capacity switching-type controller which flags...register use flag.

Additionally, the examiner requests identification of all present independent claim limitations (including structural and functional limitations linking claim elements, e.g. coupled to, responsive to) corresponding to prior art elements in the IDS documentation filed 12/12/2005, 03/20/2006 and 08/26/2003. Here again, the examiner is specifically looking for claim limitations in the list above. For each claim limitation identify a corresponding prior art element by page, line, and/or fig. Again, this request is derived from 37 CFR 1.105 and will assist in prosecuting the application.

The examiner also requests, in response to this Office action, a showing of support for the following: Correlation and identification of what structure, material, or acts set forth in the specification would be capable of carrying out the function recited in the step plus function limitations of independent claims 14 and 15; All claim language (original independent claim(s) only) that does not have antecedent basis in the descriptive portion of the specification. That is, if support for a claim limitation(s) resides solely in the original claims, such limitation must be identified; Claim language added to any present claims on amendment and any new claims. Indicate support for each claim limitation (including structural and functional language linking claim elements, e.g. coupled to, responsive to) by specifically pointing to page(s) and line no(s). in the specification and/or drawing figure(s) and the corresponding limitation. This request is derived from 37 CFR 1.105 and will assist in prosecuting the application.

In the event documentation is incorporated by reference (i.e. foreign priority application P2002-245875) there is a possibility such incorporation provides needed support for the present claims. Furthermore, it is difficult to determine whether the present application claims were

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present in the Japanese priority application (as I do not speak Japanese), therefore, it is hard to know, with certainty, whether the incorporated priority application provides needed claim support or only the present disclosure. In the event the foreign application is needed to support any claim limitation, applicant must identify such limitation(s) and corresponding English language text in the priority application.

When responding to the Office action, applicant is advised to clearly point out the patentable novelty the claims present in view of the state of the art disclosed by the reference(s) cited or the objections made. A showing of how the amendments avoid such references or objections must also be present. See 37 C.F.R. 1.111(c).

When responding to this Office action, applicant is advised to provide the line and page numbers in the application and/or reference(s) cited to assist in locating the appropriate paragraphs.

This Office action has an attached requirement for information under 37 CFR 1.105. A complete reply to this Office action must include a complete reply to the attached requirement for information. The time period for reply to the attached requirement coincides with the time period for reply to this Office action.

3. Acknowledgment is made of applicant's claim for priority under 35 U.S.C. 119. The certified copy has been received.

Any response to this action should be mailed to:

Under Secretary of Commerce for Intellectual Property and Director of the
United States Patent and Trademark Office
PO Box 1450

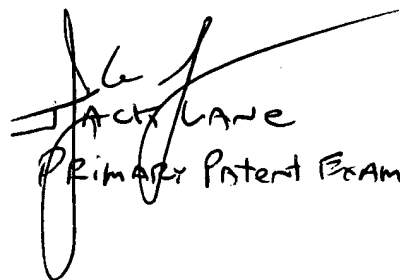
Alexandria, VA 22313-1450
or faxed to:
(571) 273-8300, (for Official communications intended for entry)
Or:
(571) 273-4208, (for Non-Official or draft communications, please label
"Non-Official" or "DRAFT")

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack A. Lane whose telephone number is 571 272-4208. The examiner can normally be reached on Mon-Fri from 7:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mano Padmanabhan can be reached on 571 272-4210.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571 272-2100


JACK LANE
PRIMARY Patent Examiner